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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,532	05/22/2000	Burkhard Neumann	016790/0392	1530

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FOLEY AND LARDNER
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[REDACTED] EXAMINER

ROSENBERGER, RICHARD A

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2877

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/575,532	NEUMANN ET AL.
	Examiner	Art Unit
	Richard A Rosenberger	2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 4/2/2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 34-36 is/are allowed.
- 6) Claim(s) 1-10, 14-16, 25 is/are rejected.
- 7) Claim(s) 11-13, 17-24 and 26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaenzer (US 6,023,378).

See the protuberance (110) on a substrate (105). The transducer "couples light to the disc surface via evanescent wave effects" (column 1, lines 43-44), the "disc" being an optical memory (column 1, lines 9-10). The transducer is coupled to the rest of the optics by "immersion" (column 1, line 39). The reference shows a lens system used in conjunction with the protuberance (110). Making the field of view of the lens system corresponding to the size of the protuberance would have been obvious because making it larger would view an area of the transducer which is functionally unresponsive to the disc and thus there is no point to having that area in the field of view, while making the field of view smaller than the protuberance would cause a responsive area of the transducer to be "lost" as a useful area. The basic functioning of the system renders it obvious to match the field of view of the lens system to the effectively useful area of the transducer, the effectively useful area being the protuberance.

3. Claims 1-10, 14-16, 25, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya (US 5,859,727) taken with Osborne et al (US 6,407,884) and Schaenzer (US 6,023,378) and in view of the acknowledged prior art of the instant specification.

Tsuchiya, in figure 7, shows a known dark field system with a refractive microscope which can be used for evanescent illumination (column 2, lines 40-44). Tsuchiya does not show the claimed "protuberance", however, it is known in similar systems to provide such a protuberance, see for example Osborne et al and Schaenzer, both of which show similar systems with such protuberances; and both Osborne et al and Schaenzer show using such a system, with a protuberance, in a memory system. The materials and methods of forming the various elements are variable within the ordinary skill in the art. In such a system, making the field of view of the lens system corresponding to the size of the protuberance would have been obvious because making it larger would view an area of the transducer which is functionally unresponsive and thus there is no point to having that area in the field of view, while making the field of view smaller than the protuberance would cause a responsive area of the transducer to be "lost" as a useful area. The basic functioning of the system renders it obvious to match the field of view of the lens system to the effectively useful area of the transducer, the effectively useful area being the protuberance.

All three references disclose immersion lenses, Tsuchiya specifically discusses oil immersion lenses. The use of known immersion lenses and immersion materials would have been obvious; the instant specification, page 10, lines 7-14, discloses that “[i]mmersions are known which . . . become plastic or elastic . . .”. The use of these known immersions would have been obvious because they are known for this purpose.

4. As set forth in the previous office action, claims 11-13, 17-24, and 26 contain allowable subject matter. These claims are objected to as being dependent from unallowed parent claims, but would be allowable if rewritten in independent form including all of the limitations of their respective parent claims. Claims 34-36 are allowable.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 308-7722.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804. The examiner's normal work schedule is 8:00 to 4:30 eastern time, Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
5 June 2003

Richard A. Rosenberger
Primary Examiner